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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,564	08/28/2001	Mary Louise Parker	515265-2004	5008
32172	7590	06/24/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			LAMB, TWYLER MARIE	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/940,564	PARKER ET AL.	
	Examiner	Art Unit	
	Twyler M. Lamb	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 August 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5-9,11-14 and 24-26 is/are rejected.
- 7) Claim(s) 4,10 and 15-23, 27 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/18/01; 3/12/03.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 6, 7, 11, 13, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshii et al. (Hoshii) (US 6,655,284) in view Miranda (US 6,190,741).

With regard to claims 1 and 13, Hoshii discloses a method for advertising, comprising the steps of: generating a high-quality photographic image having one or more image objects therein (which reads on photo images taken by a digital camera and stored on medium) (col 3, lines 52-61); placing one or more advertising data on said one or more image objects of said high-quality photographic image (col 8, line 53 – col 9, line 2), printing the high quality image and the advertising data whereby said advertising data appears to be part of said one or more image objects in the high-quality photographic image (col 9, lines 3-4).

Hoshii does not specifically teach fixing said high-quality image and advertising data to a utilitarian tableware object.

Miranda discloses method of producing a paperboard material that contains high quality images that includes fixing said high-quality image and advertising data to a utilitarian tableware object whereby said advertising data appears to be part of said one or more image objects in the high-quality photographic image (col 3, lines 43-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hoshii to include fixing said high-quality image and advertising data to a utilitarian tableware object as taught by Miranda. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hoshii by the teaching of Miranda to provide a high quality print to be used as a means of advertisement on tableware items as taught by Miranda in col 3, lines 43-45.

With regard to claim 3, Hoshii does not teach wherein said utilitarian tableware object is a beverage holder or cup/bottle holder.

Miranda discloses method of producing a paperboard material that contains high quality images that includes wherein said utilitarian tableware object is a beverage holder or cup/bottle holder (col 3, lines 43-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hoshii to include wherein said utilitarian tableware object is a beverage holder or cup/bottle holder as taught by Miranda. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hoshii by the teaching of Miranda to provide a high quality print to be used as a means of advertisement on tableware items as taught by Miranda in col 3, lines 43-45.

With regard to claims 6 and 25, Hoshii modified by Miranda discloses wherein said advertising data comprises a company logo (col 8, line 53 –col 9, line 2).

With regard to claims 7 and 24, Hoshii modified by Miranda discloses wherein said advertising data is added to said high-quality image in accordance with a digital combination technique (col 8, line 53 –col 9, line 2).

With regard to claim 11, Hoshii does not teach wherein said utilitarian tableware object is formed of a disposable material.

Miranda discloses method of producing a paperboard material that contains high quality images that includes wherein said utilitarian tableware object is formed of a disposable material (col 3, lines 28-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hoshii to include wherein said utilitarian tableware object is formed of a disposable material as taught by Miranda. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hoshii by the teaching of Miranda to provide a high quality print to be used as a means of advertisement on tableware items as taught by Miranda in col 3, lines 28-45.

3. Claims 2, 12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshii et al. (Hoshii) (US 6,655,284) in view Miranda (US 6,190,741) as applied to claims 1 and 13 above, and further in view of Johns (US 5,640,790).

With regard to claims 2 and 26, Hoshii as modified does not teach wherein said utilitarian tableware object is a plate.

Johns discloses a collectors plate kit that includes wherein said utilitarian tableware object is a plate (col 2, lines 61-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified Hoshii to include wherein said utilitarian tableware object is a plate as taught by Johns. It would have been obvious to one of

ordinary skill in the art at the time of the invention to have further modified Hoshii by the teaching of Johns to create a plate where the image data can be printed onto the plate as taught by Johns in col 2, lines 61-67.

With regard to claim 12, Hoshii as modified does not teach wherein said utilitarian tableware object is formed of a permanent material.

Johns discloses a collectors plate kit that includes wherein said utilitarian tableware object is formed of a permanent material (col 2, lines 61-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified Hoshii to include wherein said utilitarian tableware object is formed of a permanent material as taught by Johns. It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified Hoshii by the teaching of Johns to create a plate where the image data can be printed onto the plate as taught by Johns in col 2, lines 61-67.

4. Claims 5, 8, 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshii et al. (Hoshii) (US 6,655,284) in view Miranda (US 6,190,741) as applied to claim 1 above, and further in view of Breger (US 4,972,329).

With regard to claim 5, Hoshii as modified does not teach further comprising the steps of: creating a mock layout of said utilitarian tableware object; generating a blueprint of said mock layout; and generating a mold or other forming apparatus in accordance with said blueprint.

Berger discloses a system for creating dummies for wrappers that includes the steps of: creating a mock layout of said utilitarian tableware object; generating a blueprint of said mock layout; and generating a mold or other forming apparatus in accordance with said blueprint (which reads on creating images {dummies} for printing advertisements on wrappers or labels, etc) (col 2, lines 15-42; col 3, line 41 – col 4, line 56).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified Hoshii to include includes the steps of: creating a mock layout of said utilitarian tableware object; generating a blueprint of said mock layout; and generating a mold or other forming apparatus in accordance with said blueprint as taught by Berger. It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified Hoshii by the teaching of Berger to simplify the creation process of advertisement wrappers for production as taught by Berger in col 2, lines 15-42; col 3, line 41 – col 4, line 65.

With regard to claims 8 and 14, Hoshii as modified does not teach further comprising the steps of: printing said high-quality photographic image and said advertising data to the underside of a transparent film; and fixing said transparent film to said utilitarian tableware object so that said high-quality photographic image and said advertising data are visible to a user.

Berger discloses a system for creating dummies for wrappers that includes the steps of: printing said high-quality photographic image and said advertising data to the underside of a transparent film; and fixing said transparent film to said utilitarian

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tableware object so that said high-quality photographic image and said advertising data are visible to a user (which reads on creating images {dummies} for printing advertisements on wrappers or labels, etc) (col 2, lines 15-42; col 3, line 41 – col 4, line 56).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified Hoshii to include includes the steps of: printing said high-quality photographic image and said advertising data to the underside of a transparent film; and fixing said transparent film to said utilitarian tableware object so that said high-quality photographic image and said advertising data are visible to a user as taught by Berger. It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified Hoshii by the teaching of Berger to simplify the creation process of advertisement wrappers for production as taught by Berger in col 2, lines 15-42; col 3, line 41 – col 4, line 65.

With regard to claim 9, Hoshii as modified does not teach wherein said transparent film is fixed to said utilitarian tableware object in accordance with a step of forming said utilitarian tableware object out of a stock material.

Miranda discloses method of producing a paperboard material that contains high quality images that includes wherein said transparent film is fixed to said utilitarian tableware object in accordance with a step of forming said utilitarian tableware object out of a stock material (col 3, lines 28-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hoshii to include wherein said transparent film is fixed

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to said utilitarian tableware object in accordance with a step of forming said utilitarian tableware object out of a stock material as taught by Miranda. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hoshii by the teaching of Miranda to provide a high quality print to be used as a means of advertisement on tableware items as taught by Miranda in col 3, lines 28-45.

Allowable Subject Matter

5. Claims 4, 10, 15-23 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler M. Lamb whose telephone number is 571-272-7406. The examiner can normally be reached on M-Thurs 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Twyler M. Lamb
Primary Examiner
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